

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23

REMARKS

A Clean Version of the Claims was missing from the CPA Request and Amendment, filed on September 25, 2002. Enclosed is a Clean Version of the pending claims as filed on September 25, 2002.

1. Rejections based on 35 USC Section 112(2nd paragraph):

Claims 7 and 14 were rejected based on the second paragraph of 35 U.S.C. 112 for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. More particularly, Claim 7 lacked antecedent because it recited step (c). In response, Claim 7 is now amended to recite step (d) in Claim 1. Claim 7 has also been amended to correct an antecedent error discovered upon review.

Regarding the rejection of Claim 14, the Applicant requests reconsideration. Amended element (c) in Claim 1 recites "determining the physical location of said electronic device when connected to said computer wide area network." Claim 14 recites "A method of marketing, as recited in Claim 1, wherein said step (c) is carried out by a cellular telephone system capable of determining the physical location of a cellular telephone when used to connect to said wide area network." Contrary to the Examiner's understanding, the cellular telephone system recited in Claim 14 is used to determine the physical location of a cellular telephone when connected to said wide area network.

2. Rejections Based on 35 USC Section 102(b):

Claims 1, 3, 4, 13-14 were rejected under 35 USC 102(b) as being anticipated by Delorme et al.

1 In response, the Applicant traverses these rejections and requests reconsideration
2 because Delorme et al. does not disclose all of the claimed limitations recited in Claim 1.

3 MPEP §2131 provides:

4 A claim is anticipated only if each and every element as set forth in
5 the claim is found, either expressly or inherently described in a single prior
6 art reference.” *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d
7 628, 631 2 USPQ 1051, 1053 (Fed. Cir. 1987). “The identical invention
8 must be shown in as complete detail as contained in the ...claim.”
9 *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913,
10 1920 (Fed. Cir. 1989). The elements must be arranged as required by the
11 claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is
12 not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

13
14 Contrary to the Examiner’s statement, Delorme et al. does not disclose a method of
15 marketing that uses steps (a)-(g). Therefore, the anticipation rejection is unsupported by the
16 art and should be withdrawn.

17 Delorme et al. discloses a travel reservation information and planning system for a
18 motor vehicle traveler that is similar to a commercial airline reservation system. (See Col. 7,
19 lines 54-64.) Like a standard commercial airline reservation system, the Delorme system
20 prints out a travel log with driving instructions, guidance, and various transactions for
21 accommodations and other points of interest. A novel feature of the system appears to be
22 that the travel log is created from answers submitted by the user (See Col. 7, lines 22-34) as
23 he or she answers to questions presented by the system. (See Col. 6, lines 56-60.) The
24 system includes a central server that receives the inputted information from the user and uses
25 a TRIPS database to create the travel log. The TRIPS database includes the names and
26 locations of different hotel accommodations and points of interest. It also includes

1 geographical information that presents electronic maps to the user and selects various routes
2 according to distance or time. In one embodiment, a TRIPS software program is coupled to a
3 radio location receiver system that broadcasts signals to the user to determine user's location
4 and direction of travel. (See Col. 10, lines 34-58) The system also includes a computer
5 network link that allows the user to make reservations at different hotels and restaurants
6 located along the route. (See Col. 6, lines 67- Col. 7, lines 1-2.) The system includes a
7 printing feature that allows the user to print tickets immediately when creating the travel log.
8 (See generally Col. 6, lines 56-67, and Col. 7, lines 1-68, Col. 8, lines 1-68, Col. 9, 1-68, Col.
9 10, lines 1-68; Col. 11, 1-68; and Col. 12, lines 1-48.) The system also includes a
10 comparative shopping feature that allows the user to shop for the best ticket prices, (See Col.
11 7, lines 9-21). The system also provides for a mobile user to contact the TRIPS server to get
12 new updated information when traveling.

13 Applicant's claims recite a method of marketing to a mobile user of an electronic
14 device. The method uses a unique combination of steps that enables the operator of a server
15 or an advertiser connected to the network to continuously or intermittently transmit
16 advertisements to users as they travel in a region serviced by a wireless telephone system.
17 The user controls an electronic device that intermittently or continuously communicates with
18 the computer wide area network via a wireless network as the user moves in the region. The
19 electronic device is coupled to a physical location means (i.e. a GPS receiver) that determines
20 the exact location of the electronic device (hence the user) as the user moves in the region.
21 When the electronic device is connected to the computer wide area network, the physical
22 location information is automatically uploaded to the server. The physical location
23 information and the user's network identity and network connection activities are then

1 collected and stored in a user file. An advertiser or the operator of the server then reviews the
2 correct user files to select specific ads to transmit to specific users based on the three pieces
3 of information in their user file.

4 The TRIPS system of Delorme et al. does not automatically transmit selected travel
5 information to the user when the user travels through a region. More specifically, the TRIPS
6 system does not use in combination step (c) determining the physical location of the
7 electronic device when connected to the wide area network; step (d) determining the network
8 identity information and the network activity information on the electronic device when
9 connected to the wide area network; step (e) creating a user file containing network identity
10 information and physical location information; step (f) electing advertising material using
11 three different parameters – the network identity information, the physical location
12 information, and the network activity information; and step (g) transmitting the advertising to
13 the user's electronic device using the network identity information in the user file.

14 Regarding step (c), the Examiner relies on Fig.9 and its related verbiage to show that
15 Delorme's system may be used by mobile users to make travel reservations and receive travel
16 information. The Applicant disagrees. In order to receive new travel information using the
17 TRIPS system, the mobile user must contact or engage the TRIPS service provider or facility.
18 (See Col. 71, lines 61-67.) A request for information from the user is not needed in
19 Applicant's method since the electronic device is constantly connected to the wide area
20 network. This feature allows advertising material to be automatically transmitted to the user
21 whenever the user is connected to the computer wide area and traveling through a monitored
22 area.

23 Regarding step (d), the Applicant points out that "network connection activity

information” is defined in the Specification as websites or files visited by the user over the wide area network. In DeLorme et al., no disclosure or suggestion is made of using network connection activity information to identify the type of information to transmit to the user. Contrary to the Examiner’s understanding, the request and receipt of travel information over the TRIPS system is not network connection activity information as defined in Applicant’s Specification.

Step (e) recites the creation of a user file that contains three different types of information – network identity information, physical location information, and network connection activity information. Step (f) then recites the creation of a user file containing these three types of information. Step (g) then recites using the information in the user file to select advertising material to selected users. Contrary to the Examiner findings, DeLorme et al. does not disclose or suggest creating a user file containing these three types of information and then the selecting travel information to transmit to all users in a desired area.

Because the prior art reference relied upon by the Examiner in a §102 rejection does not contain every element recited in Claim 1 in as complete detail as is contained in the Claim and arranged as recited in Claim 1, the rejection is unsupported and is improper.

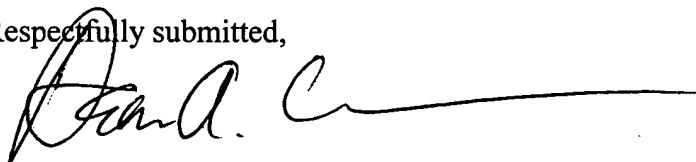
3. Rejections based on 35 USC 103:

Claims 7, 16-17-19 were rejected as being obvious in view of Delorme et al. The Applicant disagrees and requests reconsideration for the reason that the cited references do not teach the method recited in Claims 7, 16-17, and 19. As stated above, all of the elements recited in Claim 1 are not disclosed in Delorme et. al. Therefore, it should be understood that all of the claims that depend upon Claim 1 should be deemed novel and non-obvious.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23

For all of the above stated reasons, Notice of Allowance should be granted.

Respectfully submitted,



DEAN A. CRAINE, Reg. No. 33,591

Attorney for Applicant